

### Remarks

Reconsideration and withdrawal of the double patenting rejection set forth in the above-mentioned Official Action in view of the foregoing amendments and the following remarks are respectfully requested.

Claims 11-33 are now pending in the application, with Claims 11, 14, 15, 17, 19, 21-23 and 25 being independent. Claims 11, 14, 15, 17, 19, 21-23, and 25 have been amended more clearly to recite the novel features of the present invention. Claims 27, 29-31 and 33 have been amended for reasons unrelated to patentability to improve their form. Support for the amendments can be found at least in Figures 1, 2, and 5 and the corresponding discussion in the specification concerning the controller 9 and the feed roller 31 shown therein.

Applicant notes with appreciation the indication that Claims 13, 16, 18, 24, and 26 through 33 recite allowable subject matter. These claims were objected to for being dependent upon rejected base claims. However, these claims will not be rewritten in independent form at this time because their respective independent claims are believed to be allowable for the reasons discussed below.

Claims 11, 12, 14, 15, 17, 19-23 and 25 were rejected for obviousness-type double patenting as being unpatentable over Claims 1, 2, and 10-18 of U.S. Patent No. 6,702,274 in view of U.S. Patent No. 5,223,858 (Yokoi et al.). This rejection is respectfully traversed.

As implicitly recognized by the Office Action, the claims of the '274 patent do not recite ink jet printing, as is recited in each of the pending claims. Further, the patented

claims are not understood to recite the more detailed features of 1) conveying intermittently the printing medium fed by the feeding means or step to a position opposite to the printing head, and 2) scanning the print head in a scanning direction different from a conveying direction of the printing medium. To cure these deficiencies, the Examiner relies on the patent to Yokoi et al. for teaching a serial-type ink jet printing apparatus. But to establish a prima facie case of obviousness, MPEP § 2142 requires more than merely citing a second reference that contains claimed features missing from a first reference. MPEP § 2142 requires that there “be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings”.<sup>1</sup> More specifically, MPEP § 2142 requires that:

To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references."

But here, the Office Action does not allege that the Yokoi et al. patent, or the '274 patent suggests modifying the printing apparatus described in the patented claims of the '274 patent to produce a serial-type ink jet apparatus. Nor does the Office Action provide a

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<sup>1/</sup>The requirements for establishing a prima facie case of obviousness of MPEP § 2142 are understood to apply to obviousness-type double patenting rejections, since according to MPEP § 804, a “double patenting rejection of the obviousness-type is ‘analogous to [a failure to meet] the nonobviousness requirement of 35 U.S.C. 103’..., ” and therefore “....any analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. 103 obviousness determination”.

detailed line of reasoning as to why to skilled artisan would modify the invention described in the patented claims to produce a serial-type ink jet printer. As a result, the Office Action does not address the fact that serial-type printing apparatuses are not necessarily interchangeable with other kinds of printing apparatuses because they feed recording media intermittently, requiring a different kind of medium-feeding operation than other types of recording apparatus, as discussed in Applicant's original specification at page 7, lines 1-13. Rather, pages 2 and 3 of the Office Action merely appear to argue that because the references can be combined, since they are both in the general field of printing-head printing apparatus, they should be combined:

It is the examiner's position that both the 6,702,274 B1 patent and Yokoi et al are directed to printing apparatus employing print heads . . . . Since both patents are directed to printing apparatus and both employ printing heads it would have been obvious to one of ordinary skill in the art to look to Yokoi et al for the teaching of an ink jet *print head*, therefore; the references are properly combinable. (emphasis in the original)

But this kind of reasoning to establish a prima facie case of obviousness is prohibited under MPEP § 2143.01, which states that the “. . . mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination”.

Since the Office Action is understood to have failed to cite prior art suggesting the desirability of modifying the claims of the '274 patent to produce the invention of Applicant's independent claims, the Patent Office is not understood to have established a prima facie case of obviousness-type double patenting against independent Claims 11, 14,

15, 17, 19, 21-23 and 25. For this reason, Applicant respectfully requests that the rejection of Claims 11, 14, 15, 17, 19, 21-23 and 25 be withdrawn.

MPEP § 2142 further requires that to establish a prima facie case of obviousness, there be a reasonable expectation of success when modifying the art to produce the claimed invention. But, here, the Office Action has provided no evidence that the printing apparatus of the claims of the '274 patent could be successfully transformed by one of ordinary skill in the art into a serial-type ink jet printing apparatus —a completely different kind of printing apparatus — based on the teachings of the Yokoi et al. patent. Absent such evidence, the Patent Office is not understood to have established a reasonable expectation of success in modifying the claimed invention of the '274 patent to produce the invention of Applicant's independent claims, as also required by MPEP § 2142. For this additional reason, the Patent Office is not understood to have established a prima facie case of obviousness against amended independent 11, 14, 15, 17, 19, 21-23 and 25.

Accordingly, Applicant respectfully requests that the rejection of Claims 11, 14, 15, 17, 19, 21-23 and 25 be withdrawn for this additional reason.

For the foregoing reasons, Applicant respectfully submits that the present invention is patentably defined by independent Claims 11, 14, 15, 17, 19, 21-23 and 25. Dependent Claims 12, 15, and 20 are also allowable, in their own right, for defining features of the present invention in addition to those recited in their respective independent claims. Individual consideration of the dependent claims is requested.

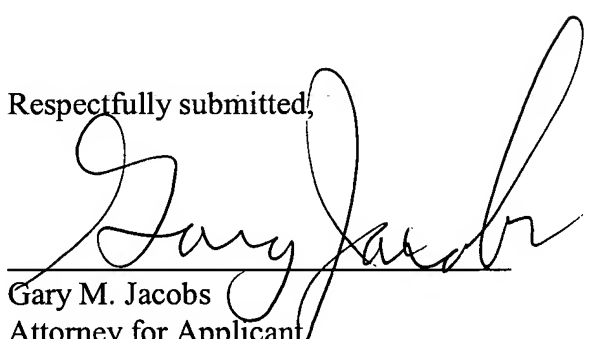
This Amendment After Final Rejection does not raise new issues, is an earnest attempt to advance prosecution and reduce the number of issues, and is believed to clearly

place this application in condition for allowance. This Amendment was not earlier presented because Applicant earnestly believed that the prior Amendment placed the subject application in condition for allowance. Accordingly, entry of this Amendment under 37 CFR 1.116 is respectfully requested.

In view of the above amendments and remarks, Applicant submits that the present application is in condition for allowance. Therefore, favorable reconsideration, withdrawal of the rejection set forth in the above-noted Office Action, and an early issuance of a Notice of Allowability are requested.

Applicant's undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 530-1010. All correspondence should continue to be directed to our below-listed address.

Respectfully submitted,



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